

### **REMARKS**

This responds to the Office Action mailed on February 8, 2008.

Claims 51 and 52 are amended, claims 1-26, 30, 36-37, 41 and 47-48 are canceled, and no claims are added; as a result, claims 27-29, 31-35, 38-40, 42-46 and claims 49-56 are now pending in this application.

#### **§112 Rejection of the Claims**

Claims 51-52 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness.

In response to the rejection, the claims 51-53 were amended. Applicants, respectfully request withdrawal of the rejection.

#### **§103 Rejection of the Claims**

Claims 27-29, 31-35, 38-40 and 42-46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Carlin et al. (U.S. 6,119,152; hereinafter Carlin) and “Domain Names – Concepts and Facilities” (hereinafter RFC 1034) ) and Lowery et al. (U.S. Patent No. 5,894,554, hereinafter “Lowery”).

Applicants respectfully submit that the rejection of the aforementioned claims under 35 U.S.C. § 103 is defective for the reason that prior art references when combined do not teach or suggest all of the claim limitations of the independent claims of the present application.

#### **Applicable Law**

In rejecting claims under 35 U.S.C. §103, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See M.P.E.P. §2142. In the recent decision of the Supreme Court on *KSR Int’l Co. v. Teleflex Inc.*<sup>1</sup>, the analysis of obviousness previously set forth in *Graham v. John Deere Co. of Kansas City*<sup>2</sup>, was reaffirmed. The Court in *Graham* set out an objective analysis for applying §103 as follows:

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background

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<sup>1</sup> 127 S.Ct. 1727, 82 USPQ.2d 1385 (2007).

<sup>2</sup> 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966).

the obviousness or nonobviousness of the subject matter is determined.”<sup>3</sup>

When claim elements are found in more than one prior art reference, the fact finder must determine “whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims.” *In re Kahn*<sup>4</sup>. In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co. of Kansas City*<sup>5</sup>. Further, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*<sup>6</sup>. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*<sup>7</sup>. Office personnel must rely on the applicant’s disclosure to properly determine the meaning of the claims. *Markman v. Westview Instruments*<sup>8</sup>.

Applicants believe that the issue of patentability over Carlin in combination with RFC 1034 and Lowery is best understood with regard to claim 27.

Claim 27, as amended, includes the following limitation:

*a first sales interface at a first network address...*

*a second sales interface at a second network address...*

*a sales server at a third network address that operates the first and second sales interfaces...the sales server is operative to create the impression that the sales interfaces are being operated by different domains ...the first sales interface includes links to a first set of pages not operated by the sales server but being mapped to the first domain, and the second sales interface includes links to a second set of pages not operated by the sales server but being mapped to the second domain*

*a first member server at a fourth network address to operate the first set of pages; and*

*a second member server at a fifth network address to operate the second set of pages,*

<sup>3</sup> The Court in *KSR v. Teleflex*, at page 1730, quoted the analysis of *Graham* from page 18.

<sup>4</sup> 441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006).

<sup>5</sup> 383 U.S. 1 at 467.

<sup>6</sup> 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

<sup>7</sup> 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

<sup>8</sup> 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (*en banc*), *aff'd*, U.S., 116 S. Ct. 1384 (1996).

The Office Action, in rejecting claim 27, relies on Carlin and specifically cites the following:

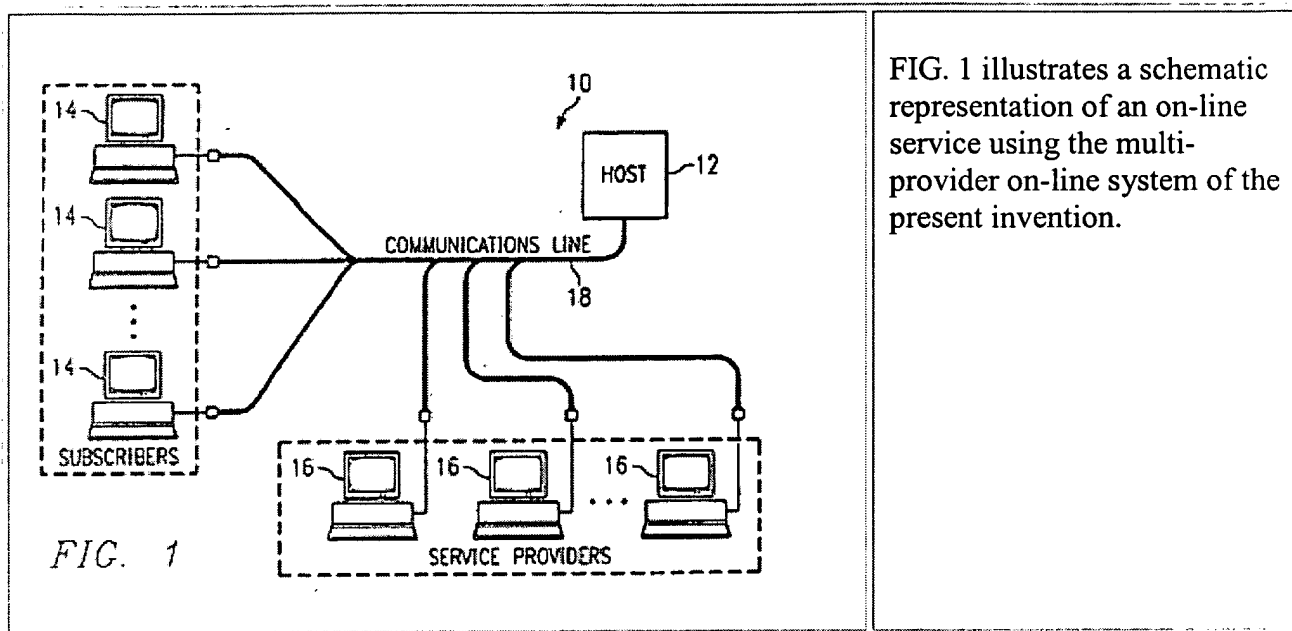
In the present invention, a multi-provider on-line service offers a number of on-line services. The multi-provider on-line system may be uniquely configured by a plurality of service providers, such that each service provider can offer its own subset of features to its subscribers and customize the appearance of the user interface. Each subscriber is associated with a service provider, typically through a subscriber ID. When a subscriber logs on to the on-line system, he or she may access the subset of features determined by the service provider.

The present invention provides significant advantages over the prior art. A company or individual who wishes to provide a private on-line system can customize the multi-provider on-line system to offer the desired features. Subscribers to a particular service have access only to those features chosen by their service provider, and subscribers to other services on the multi-provider on-line service do not have access to the particular service's private data, unless such data has been authorized for public use. Hence, each provider can generate an on-line service which appears to the subscriber to be an independent on-line service. However, because the multi-provider host can economically offer advanced features to the service providers, each service provider can offer features which might otherwise be impractical for a small service provider. Further, the service provider does not need to maintain the equipment for providing the on-line service or concern itself with billing matters.

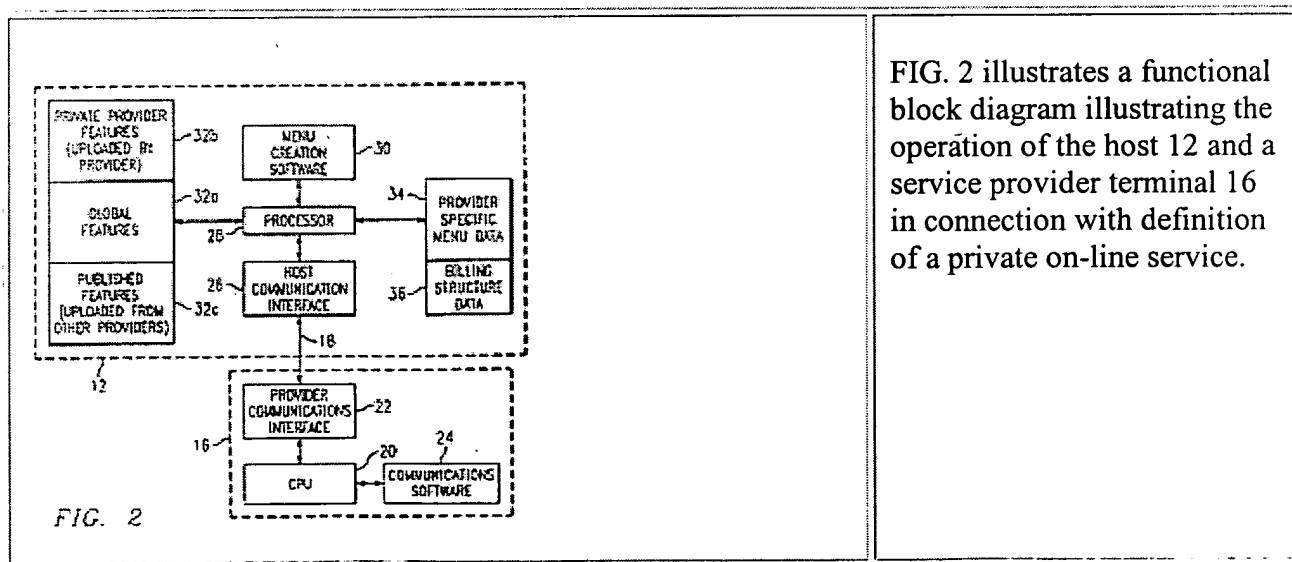
Carlin, col. 2, lines 10-38.

The above material from Carlin which is relied upon in the Office Action relates a multi-provider on-line system. As stated, the multi-provider on-line system may be configured by multiple service providers. Each service provider may offer its own subset of features to its subscribers. Subscribers to a particular service have access only to those features chosen by their service provider. The multi-provider host can offer advanced features to the service providers that might otherwise be impractical for a small service provider. The service provider does not need to maintain the equipment for providing the on-line service or concern itself with billing matters.

The following figures from Carlin highlight the multi-provider on line system:



Carlin, Figure 1 and Col. 3, lines 14-17.



Carlin, Figure 2 and Col. 5, lines 55-58.

The above Figures and quotes from Carlin relate to Carlin's multi-provider system including a host computer 12, subscriber terminals 14 and service provider terminals 16.

Claim 27 requires “a sales server ...that operates the first and second sales interfaces,” the “sales server” being “operative to create the impression that the sales interfaces are being operated by different domains.” In addition, “the first sales interface includes links to a first set of pages not operated by the sales server ....and the second sales interface includes links to a second set of pages not operated by the sales server.” Finally, claim 27 requires “a first member server ...to operate the first set of pages” and “a second member server ...to operate the second set of pages.”

In contrast, Carlin relates a multi-provider on-line system that provides on-line service to the subscribers and service providers that do not provide on-line service to the subscribers. Specifically, the service provider terminals 16 in the above Figure 1 from Carlin are merely used to configure the host and are not used to provide on-line services to the subscribers. Further, Carlin fails to relate any details regarding the internal operations of the host. Accordingly, the portions of Carlin relied upon in the Office Action cannot be said to teach or suggest the limitations of claim 27.

Moreover, Carlin teaches away from the solution of claim 27 because Carlin considers it advantageous for the host to exclusively provide on-line services to the subscribers. Carlin highlights the following features: 1) “the multi-provider host can economically offer advanced features to the service providers;” 2) “each service provider can offer features which might otherwise be impractical for a small service provider” and 3) “the service provider does not need to maintain the equipment for providing the on-line service or concern itself with billing matters.”<sup>9</sup>

Carlin therefore fails to teach or suggest the above quoted limitation of claim 27 because Carlin relates a multi-provider on-line system that provides on-line service to the subscribers and service providers that do not provide on-line service to the subscribers while, in contrast, claim 27 requires “a sales server ...that operates the first and second sales interfaces,” the “sales server” being “operative to create the impression that the sales interfaces are being operated by

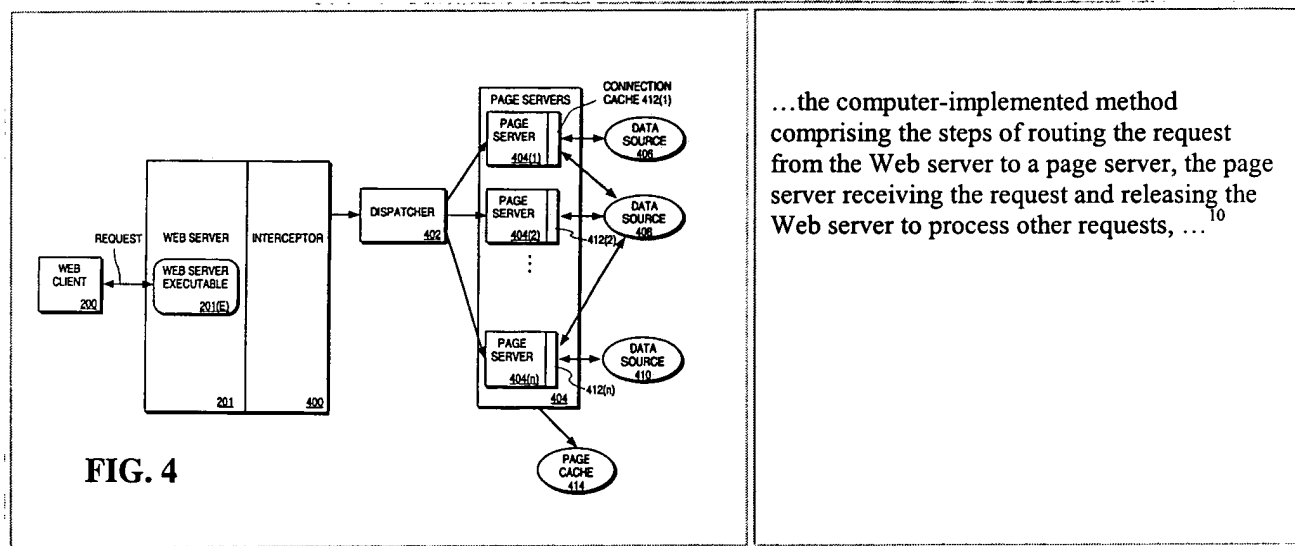
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<sup>9</sup> Carlin, col. 2, lines 30-39.

different domains.” In addition, “the first sales interface includes links to a first set of pages not operated by the sales server ....and the second sales interface includes links to a second set of pages not operated by the sales server.” Finally, claim 27 requires “a first member server ...to operate the first set of pages” and “a second member server ...to operate the second set of pages.”

The portion of RFC 1040 quoted by the Office Action relates to a relationship between a domain and a sub-domain. Accordingly, RFC 1040 cannot supply what Carlin lacks.

The Office Action, in rejecting claim 27, further relies on the following figure and quote from Lowery:



Lowery relates a web server that intercepts a request and routes the request to one of multiple page servers.

Claim 27 requires “a sales server ...that operates the first and second sales interfaces,” the “sales server” being “operative to create the impression that the sales interfaces are being operated by different domains.” In addition, “the first sales interface includes links to a first set of pages not operated by the sales server ....and the second sales interface includes links to a second set of pages not operated by the sales server.” Finally, claim 27 requires “a first member

<sup>10</sup> Lowery, excerpt from Abstract.

server ...to operate the first set of pages” and “a second member server ...to operate the second set of pages.”

Accordingly, Lowery cannot provide what is lacking in Carlin. Specifically, Lowery relates a web server that intercepts a request that is routed to one of multiple page servers and is silent with regard to “a first member server ...to operate [a] first set of pages” and “a second member server ...to operate [a] second set of pages” where “[a] first sales interface includes links to [the] first set of pages ....and [a] second sales interface includes links to [the] second set of pages” further where “a sales server ... operates the first and second sales interfaces.” Accordingly, the portions of Lowery relied upon in the Office Action also fail to teach or suggest the quoted limitations of claim 27.

Carlin in combination with RFC 1040 and / or Lowery therefore fails to teach or suggest the above quoted limitation of claim 27 because Carlin is silent with regard to member servers, Lowery relates a “request” that is intercepted at a “web server” and routed to one of multiple “page servers,” and RFC 1040, as alleged by the Office Action, relates to a relationship between a domain and a sub-domain. In contrast, claim 27 requires “a sales server ...that operates the first and second sales interfaces,” the “sales server” being “operative to create the impression that the sales interfaces are being operated by different domains.” In addition, “the first sales interface includes links to a first set of pages not operated by the sales server ....and the second sales interface includes links to a second set of pages not operated by the sales server.” Finally, claim 27 requires “a first member server ...to operate the first set of pages” and “a second member server ...to operate the second set of pages.”

The above remarks are also applicable to a consideration of independent claims 35, 38 and 46.

In addition, if an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 28, 29, 31-34, 39-40, and 42-45 under 35 U.S.C. § 103 is also addressed by the above remarks.

In summary the Office Action in rejecting of the independent claims of the present application under 35 U.S.C. § 103 fails to provide a rationale showing that Carlin, whether considered separately or in combination with either RFC 1040 and/or Lowery, teaches or

suggests each and every limitation of independent claims 27, 35, 38 and 46 to support a *prima facie* case of obviousness. The rejection is improper and should be reconsidered and withdrawn.

### **Reservation of Rights**

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.



**CONCLUSION**

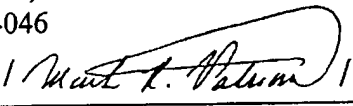
Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-278-4046 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date July 8, 2008

By   
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